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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,206	12/18/1998	DAVID WILLIAM ROTH	B2745.0025/P0025	1079

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BEH INVESTMENTS LLC
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EXAMINER

VAN BRAMER, JOHN W

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3622

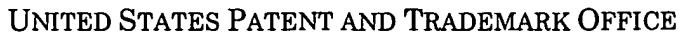
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



APR 27 2011

With regards to applicants' request for entry of the substitute specification filed January 22, 2004 and March 5, 2007, the examiner indicated in the non-final Office action mailed December 22, 2010 that "the present application and the 08/787,979 application were not eligible for claiming continuation-in-part status during the copendency of the

application, and the ability to claim continuation-in-part status only occurred two years after the 08/787,979 application had already issued for patent the amendment to the Specification fails to satisfy the requirements of MPEP 201.08. As such, the amendments are not entered." The examiner's refusal for entry of the amendment is based on the reason that the instant application and the '979 application were not copending **at the time of the amendment**. The examiner is misguided. There is no requirement for copendency at the time the claim for benefit is made. 35 USC 120 requires that the later-filed application be "filed before the patenting or abandonment of or termination of proceedings on the first application." In other words, it is required that the instant application, **at time of filing**, be copending with the '979 application.

The substitute specification denied entry by the examiner attempts to insert material from the '979 application. MPEP 201.06(c) sets forth that "an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, an explicit statement that such specifically enumerated prior application or applications are "hereby incorporated by reference....**The inclusion of this incorporation by reference statement will permit an applicant to amend the continuation or divisional application to include subject matter from the prior application(s)** without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference." Furthermore, 37 CFR 1.57(f) sets forth that "any insertion of material incorporated by reference into the specification or drawings of an application must be by way of an amendment to the specification or drawings. Such an amendment must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter." However, the examiner may require the applicant to supply a copy of the material incorporated by reference. If the Office requires the applicant to supply a copy of material incorporated by reference, the material must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application (37 CFR 1.57(e)).

A review of the application shows that Applicants have expressed a clear intent to incorporate by reference the '979 application on page 5, lines 13-14 of the specification, i.e., "the above referenced co-pending application is hereby incorporated herein by reference in its entirety." Furthermore, on January 22, 2004, applicants provided an amendment to the specification which included insertion of material incorporated by reference. The amendment was also accompanied by a statement by the applicants that "the amendment to the specification do not constitute new matter". In the Remarks section of the response filed January 22, 2004, applicants' provided a statement that "the insertion of entire portions from Patent Application Serial No. 08/787,979, now U.S. Patent No. 6,285,987 ("the '987 Patent). The '987 Patent was incorporated by reference in the original specification at page 5 lines 10 to 14." Normally, this statement would be proper to meet the requirement of 37 CFR 1.57(f); however, applicants further go on to state that "rephrasing of several paragraphs" have occurred. Thus the requirement of 37 CFR 1.57(f) has not been fully met.

Accordingly, the application will be returned to the examiner for determination of whether the "rephrasing of several paragraphs" is permissible within the scope of 37 CFR 1.57(f); if so, the amendments will be entered. If necessary, the Examiner may require the applicant to supply a copy of the material incorporated by reference.

Any inquiries regarding this decision should be directed to Teri P. Luu, Quality Assurance Specialist, at (571) 272-7045



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WC/tl: 04/26/11

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